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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,845	03/09/2000	Janos Szanyi	1434A2	3769

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PPG INDUSTRIES INC
INTELLECTUAL PROPERTY DEPT
ONE PPG PLACE
PITTSBURGH, PA 15272

EXAMINER

PIZIALI, ANDREW T

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 10/09/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/521,845	SZANYI ET AL.	
	Examiner	Art Unit	
	Andrew T Piziali	1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3, 6-11, 14-16, 18-23, 26-32, 35-38, 41, 49-53 and 58-60 are rejected under 35

U.S.C. 112, first paragraph, because the specification, while being enabling for a breaker layer comprising a metal oxide doped with phosphorous and/or silicon, does not reasonably provide enablement for any conceivable "breaker layer" either presently existing or which might be discovered in future. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

3. Claims 1-15, 18-41, 49-53 and 59-60 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a first and second coating surface (or layer) comprising a metal oxide, does not reasonably provide enablement for any conceivable first or second surface (or layer) either presently existing or which might be discovered in future. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

4. Claims 42-44, 49-53, 57 and 61 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a color suppression layer comprising a gradient layer which transitions from one metal oxide or nitride to another, does not reasonably

Art Unit: 1775

provide enablement for any conceivable color suppression layer either presently existing or which might be discovered in future. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

5. Claims 1-17 and 19-25 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A substrate appears to be critical or essential to the practice of the invention. Unless there is some evidence that the layer can stand alone, the claim is incomplete in the absence of a substrate.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-3, 6-11, 14-16, 18-23, 26-32, 35-38, 41, 49-53 and 58-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims set forth a physical characteristic desired in the breaker layer, but fail to set forth a specific composition(s) for the breaker layer. Claims merely setting forth a physical characteristic desired in article, and not setting forth specific compositions which would meet such a characteristic, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart the desired characteristic.

8. Claims 1-15, 18-41, 49-53 and 59-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims set forth a physical characteristic

Art Unit: 1775

(crystalline) desired in the first and/or second coating surface (or layer), but fail to set forth a specific composition(s) for the first and/or second coating surface (or layer). Claims merely setting forth a physical characteristic desired in article, and not setting forth specific compositions which would meet such a characteristic, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart the desired characteristic.

9. Claims 42-44, 49-53, 57 and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims set forth a physical characteristic desired in the color suppression layer (suppresses color), but fail to set forth a specific composition(s) for the breaker layer. Claims merely setting forth a physical characteristic desired in article, and not setting forth specific compositions which would meet such a characteristic, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart the desired characteristic.

10. Claims 46-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims set forth a physical characteristic (refractive index) desired, but fail to set forth specific compositions for the layers. Claims merely setting forth a physical characteristic desired in article, and not setting forth specific compositions which would meet such a characteristic, are invalid as vague, indefinite, and functional since they cover any

Art Unit: 1775

conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart the desired characteristic.

11. Claims 19-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are drawn to “The coating according to claim 18”, but claim 18 is drawn to a coated article. Appropriate correction is required.

12. Claims 44 and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how the thickness of the second layer can be “inversely proportional” or “substantially inversely proportional” to the thickness of the first layer.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 1775

14. Claims 46-48 and 54-56 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,218,018 to McKown et al. (hereinafter referred to as McKown).

Regarding claims 46-48, McKown discloses numerous variations of depositing on a glass substrate a layer of tin oxide doped with fluorine and a layer of tin oxide doped with antimony (see entire document).

Regarding claims 54-56, McKown discloses that the coated article may comprise a substrate with a gradient layer deposited thereon comprising tin oxide doped with fluorine and antimony (column 7, lines 21-56 and Figure 3).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 45 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,218,018 to McKown.

Regarding claim 45, McKown discloses numerous variations of depositing on a glass substrate a layer of tin oxide doped with phosphorous or fluorine and a layer of tin oxide doped with antimony (see entire document). McKown discloses that a gradient layer may be used and gives an example in which an antimony doped tin oxide layer is deposited on a glass substrate followed by a fluorine doped tin oxide layer, wherein the antimony doped tin oxide layer has four stratas with different antimony concentrations (Example 39, paragraph bridging columns 11

Art Unit: 1775

and 12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust the thicknesses, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

Regarding claim 57, McKown discloses that the coated article may comprise a substrate with a gradient layer deposited thereon comprising tin oxide doped with fluorine and antimony (column 7, lines 21-56 and Figure 3). McKown discloses that a color suppression layer may be deposited on the substrate according to the two layer assemblage provided by the present invention (column 5, lines 14-21). McKown does not specifically mention depositing the color suppression layer on the substrate of the gradient layer assemblage provided by the present invention, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the color suppression layer in the gradient layer assemblage, because it may improve the color neutrality of the coated glass article.

Response to Arguments

17. Applicant's arguments with respect to claims 1-61 have been considered but are moot in view of the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T Piziali whose telephone number is (703) 306-0145. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (703) 308-3822. The fax phone numbers for the

Art Unit: 1775

organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5665.

gtp

atp
October 4, 2002

Andrew T Piziali
Examiner
Art Unit 1775

Deborah Jones
DEBORAH JONES
SUPERVISORY PATENT EXAMINER